

REMARKS**Status of the Claims**

Upon entry of the amendment above, claims 1-23 and 25-40 will be pending, claims 1, 19, and 30 being independent.

Summary of the Office Action

Claims 10-12 stand withdrawn from consideration as being directed to non-elected invention(s).

Claims 1, 8, 9, 14, 16, 19-24, 27-35, and 38-40 are rejected under 35 USC §102(e) as being anticipated by DACHGRUBER et al. (U.S. Patent No. 6,360,454, hereinafter "DACHGRUBER").

Claims 3, 5-7, 18-21, 23-36, and 38-40 are rejected under 35 USC §102(e) as being anticipated by FILICE (U.S. Patent No. 6,381,877).

Claims 2 and 4 are rejected under 35 USC §103(a) as being unpatentable over DACHGRUBER in view of OTTIERI (U.S. Patent No. 4,669,202), or in view of DODGE et al. (U.S. Patent No. 4,841,650, hereinafter "DODGE").

Claims 13 and 15 are rejected under 35 USC §103(a) as being unpatentable over DACHGRUBER in view of GRAY et al. (U.S. Patent No. 3,841,004, hereinafter "GRAY"), or in view of MacQUAID et al. (U.S. Patent No. 3,175,292, hereinafter "MacQUAID"), or in view of FILICE.

Claims 17 and 37 are rejected under 35 USC §103(a) as being unpatentable over FILICE in view of DACHGRUBER or PEROTTO et al. (U.S. Patent No. 5,050,319, hereinafter "PEROTTO").

Response to the Office Action**A. Summary of the Amendment**

Applicant has made certain amendments to the claims in response to a comment in the Office action that "'rigid' is a relative term," and that "A material appears to be 'rigid' to one person might appear to be 'flexible' to another."

Although Applicant submits that, in the context of his disclosure, coupled with the ordinary meaning that the term would be granted by one skilled in the art, the term "rigid" would be understood as distinguishing over something that would not possibly perform the abutment and flexion limiting functions, the claims as amended, *i.e.*, claims 1, 19, 30, 35, and the cancellation of claim 24, should advance prosecution regarding the issue.

B. Withdrawal of Rejections That Rely Upon DACHGRUBER

Reconsideration and withdrawal of the rejections, both under 35 USC §102(e) and under 35 USC §103(a), based solely or primarily upon DACHGRUBER, are requested at least for the following reasons.

At the beginning of the §102(e) rejection, it is stated that DACHGRUBER "shows every claimed feature of the claims including a rigid frame 24 (figures 1, 3), one bending zone with an abutment 100, or 102, or 98."

The sentence bridging pages 2 and 3 of the Office action reads as follows:

It appears that the aperture 100, or the notches 98, or the element 102 has abutting surfaces (for element 102, when device 24 is bent at certain degree, abutting surfaces will be the side surface of element 102 and the surface of device 24 which is adjacent to the side surface of element 102), and when the device 24 of Dachgruber et al is flexed at certain degree, the abutting surfaces function to limit flexion to some degree.

The argument that "the abutting surfaces [of Dachgruber] function to limit flexion to some degree" is repeated in the paragraph bridging pages 5 and 6 of the Office action, in comments responding to Applicant's prior reply.

Applicant respectfully submits that the disclosure of DACHGRUBER fails to support this contention. If Applicant is wrong on this point, he kindly requests that a relevant passage of the text of DACHGRUBER be cited for Applicant's consideration.

1. Notches 98 of DACHGRUBER are Not Abutments

Notches 98 of DACHGRUBER, cited in the rejection as "abutments," are not abutments. Instead, DACHGRUBER describes the notches 98 as follows (see column 7, lines 50-65):

... one or both sides 39a, 39b [of the stiffener 24] may include a plurality of *flex inducing members such as grooves or notches 98*
* * * ... due in part to the presence of the grooves, the mid-section is able to *flex* to a greater extent than other portions of the stiffener. The grooves 98 may also act to minimize kinking of the mid-section of the stiffener as the tongue and stiffener are flexed. In this respect, *the grooves 98 provide controlled flexing of the stiffener* (emphasis added).

Thus, rather than acting as an *abutment* to limit bending of a user's joint, such as an ankle, *the grooves 98 of DACHGRUBER do the opposite --- they promote bending*. Although DACHGRUBER comments that the grooves 98 can be "sized and shaped to provide a desired rigidity or stiffness" (column 7, lines 56-58), the grooves nevertheless enhance the flexibility of the stiffener 24. The size and shape of the grooves 98 within the stiffener can be used to enhance such flexibility by a relative less or greater extent.

In any event, Applicant submits that DACHGRUBER's written disclosure is quite clear that the grooves 98 act to promote flexion; further there is no written disclosure in DACHGRUBER that such grooves are abutments *against* flexing or bending of the stiffener 24.

If, in spite of the specific description in DACHGRUBER to the contrary, the rejection is to be premised upon grooves 98 being considered "abutments," Applicant submits that the rejection is based upon speculation and conjecture, since the rejection has pointed to no relevant disclosure in DACHGRUBER or provided any explanation as to why the grooves 98 are necessarily abutments in the manner claimed by Applicant. Thus, the rejection, as to grooves 98, does not present a *prima facie* case of anticipation based upon the disclosure of DACHGRUBER. *See, e.g., In re Woodruff*, 16 USPQ2d 1934 (Fed. Cir. 1990).

2. Apertures 100 of DACHGRUBER are Not Abutments

Apertures 100 of DACHGRUBER, cited in the rejection as "abutments," are not abutments. Instead, DACHGRUBER describes the apertures 100 as follows (see column 7, line 66, to column 8, line 4):

In addition, at least one aperture 100 may be formed completely through the stiffener 24, with the aperture 100 being shaped and dimensioned in accordance with the desired flexibility or rigidity. Like the grooves 98, the apertures 100 may also act to minimize kinking of the stiffener as the tongue and stiffener are flexed.

Thus, the apertures 100, according to DACHGRUBER, serve the purpose of that of the grooves 98.

Accordingly, as with the grooves 98, DACHGRUBER's written disclosure is quite clear that the apertures 100 act to promote/control flexion and can be shaped and dimensioned in a way to set the flexion at a predeterminate level; further there is no written disclosure in DACHGRUBER that such apertures are abutments *against* flexing or bending of the stiffener 24.

A reliance on apertures 100 as "abutments," is a reliance upon speculation and conjecture to reject Applicant's claims, since the rejection has pointed to no relevant disclosure in DACHGRUBER or provided any explanation as to why the apertures 100 are necessarily abutments in the manner claimed by Applicant. Thus, the rejection, as to apertures 100, does not present a *prima facie* case of anticipation based upon the disclosure of DACHGRUBER.

3. Stiffness Adjusters 102 of DACHGRUBER are Not Abutments

Stiffness adjusters 102 of DACHGRUBER, cited in the rejection as "abutments," are not abutments. Instead, DACHGRUBER describes the stiffness adjusters 102 as follows (see column 8, lines 4-16):

The flexibility or rigidity of a single stiffener 24 may be further adjusted by providing a stiffness adjuster 102, which may fit into the aperture 100, or any other suitable aperture formed in the stiffener. * * * Accordingly, a wearer may adjust the flexibility by selecting a desired type or number of stiffness adjusters 102.

Thus, the stiffness adjusters 102, according to DACHGRUBER, function to modify the stiffness/flexibility of the stiffener 24 and not as abutments to *limit* flexing or bending beyond a certain point.

Accordingly, as with the grooves 98 and the apertures 100, DACHGRUBER's written disclosure is quite clear that the stiffness adjusters 102 act to promote/control flexion and can be shaped and dimensioned in a way to set the flexion at a predeterminate level; further there is no written disclosure in DACHGRUBER that such adjusters *against* flexing or bending of the stiffener 24.

A reliance on stiffness adjusters 102 as "abutments," is a reliance upon speculation and conjecture to reject Applicant's claims, since the rejection has pointed to no relevant disclosure

in DACHGRUBER or provided any explanation as to why the stiffness adjusters 102 are necessarily abutments in the manner claimed by Applicant. Thus, the rejection, as to stiffness adjusters 102, does not present a *prima facie* case of anticipation based upon the disclosure of DACHGRUBER.

At least for the reasons above, and reasons advanced in Applicant's reply to the prior Office action, reconsideration and withdrawal of the rejections are requested.

C. Withdrawal of Rejections That Rely Based Upon FILICE

Reconsideration and withdrawal of the rejections, both under 35 USC §102(e) and under 35 USC §103(a), based solely or primarily upon FILICE, are requested at least for the following reasons.

The rejections that rely solely or primarily upon FILICE are new grounds of rejection, *i.e.*, not advanced in the prior Office action.

FILICE discloses a boot having a flexible ankle cuff section (see column 1, lines 33-38). The ankle cuff section is constructed of synthetic material of equal or greater flexibility than the lower and the upper sections of the boot (see column 1, lines 47-50). The ankle cuff section 40 and the flexible tongue section 26 are each constructed and designed to provide controlled flexibility, *i.e.*, controlled to have an equal or greater flexibility in desired directions than the lower or the upper sections 10, 30 of the boot and the upper and lower parts 22, 24 of the tongue (see column 2, lines 44-52).

Section 26 is flexible (see column 3, lines 8-12 and lines 26-31). It is also explained (see, *e.g.*, column 4, lines 1-8) that the relatively thick central region 27 of the tongue abuts the lateral edges 44 of the flexible cuff section. This prevents migration of the tongue 20 from the desired frontal position to the left or to the right of the user's foot.

In any event, *there is no disclosure of an abutment, nor of an abutment that limits bending beyond a predetermined angle.*

As with the rejection based upon DACHGRUBER, a reliance on elements 28, 46 of FILICE as "abutments," as recited in the rejected claims, is a reliance upon speculation and conjecture, since the rejection has pointed to no relevant disclosure in FILICE or provided any explanation as to why the elements 28, 46 are necessarily abutments in the manner claimed by Applicant. Thus, the rejection based upon FILICE does not present a *prima facie* case of anticipation based upon the disclosure of DACHGRUBER.

At least for the reasons above, reconsideration and withdrawal of the rejections are requested.

Acknowledgement of Consideration of Patent Abstract of Japanese Document

Applicant kindly requests that the Examiner indicates consideration of the following document that was listed lowermost on the PTO-1449 form that was filed with Applicant's information disclosure statement on February 5, 2002: "Patent Abstracts of Japan," Vol. 1996, No. 09, published September 30, 1996, an abstract of Japanese Publication No. 08-134705 (HISATOMI:KK), published May 28, 1996."

SUMMARY AND CONCLUSION

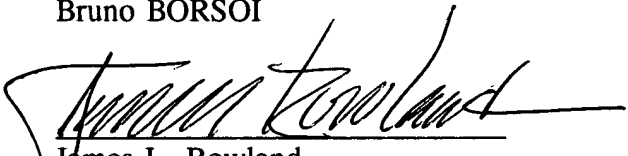
The grounds of rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

No fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Further, although no extension of time is believed to be necessary at this time, if it were to be found that an extension of time were necessary to render this reply timely and/or complete, Applicant requests an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) to render this reply timely and/or complete and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,
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March 28, 2005
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